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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/998,079
Filing Date: November 30, 2001
Appellant(s): WONG ET AL.

Chad E. Bement
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 02/21/2006 appealing from the Office action mailed on 09/19/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The rejection of dependent claims 3-10 stand or fall with independent claim 1.

The rejection of dependent claims 13-20 stand or fall with independent claim 11.

The rejection of dependent claims 23-29 stand or fall with independent claim 21.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent Number: 5,929,848	Albukerk et al.	July 27, 1999
Pub. Number: US 2002/0078075	Colson et al.	December 15, 2000
Pub. Number: US 2002/0019584	Schulze et al.	March 1, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848) in view of Colson et al. (Pub. No.: US 2002/0078075).

Claims 4-6, 14-15, 17, 24-25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848) in view of Schulze et al. (Pub. No.: US 2002/0019584). These rejection are set forth in a prior Final Office Action, mailed on 09/19/2005.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848, hereinafter, "Albukerk") in view of Colson et al. (Pub. No.: US 2002/0078075, hereinafter, "Colson").

Regarding claim 1, 11, and 21, Albuberk teaches a method and a portable electronic device, comprising: a processor (see figure 2, PID 101, processor 207, col.9, ln.16-18); a transceiver coupled to the processor (see figure 2, transmitter 217, receiver 203), the transceiver configured to receive and transmit communication signals (see figure 2, transmitter 217, receiver 203); a memory coupled to the processor (see figure 2, memory 209, processor 207); and a program stored in the memory and running on the processor configured to receive an association

signal by the transceiver (see col.10, ln.53-67), the association signal providing an indication of adjacent resources (see figure 1, object identification device 107a send a resource signal to PID 101a, the signal 109a is associated with object 103a, col.9, ln.23-54), the program further configured to access a database including a table storing relationships between data stored on the portable electronic device and the association signal (see figure 1, col.9, ln.10-54, when PID 101a receives the signal from OID 107a, the processor will access to the storage device 205 for checking the associated data that corresponding to the receiving signal), and the program configured to index the data based on the relationships accessed in the database (see figure 4, col.10, ln.11-53, i.e., index is corresponding objected identifier 401, objected type 403).

It should be noticed that Albuberk fails to teach the prioritizing data. However, Colson teaches such features (see figure 1, prioritization system 10, [0023, 0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albuberk, in order to store and process the priority data from the database.

Regarding claims 3, 7, 13, 18, and 23, Albuberk further teaches the method and portable electronic device, wherein the association signal includes a signal from a wireless access point (see figure 1, OID 107a, col.8, ln.14-29).

Regarding claims 8, 16, and 26, Albuberk further teaches the method and portable electronic device, wherein the association signal includes an infrared signal (see col.8, ln.25).

Regarding claims 9, 19, and 28, Albuberk further teaches the method and portable electronic device, further comprising: retrieving data stored on the portable electronic device and related to the associating signal (see col.9, ln.10-31).

Regarding claims 10, 20 and 29, Albuberk further teaches the method and portable electronic device further comprising: displaying the data retrieved (see col.11, ln.15-25).

3. **Claims 4-6, 14-15, 17, 24-25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848, hereinafter, "Albukerk") in view of Schulze et al. (Pub. No.: US 2002/0019584, hereinafter, "Schulze").**

Regarding claims 4, 14, and 24, Albuberk teaches a method and a portable electronic device, comprising: a processor (see figure 2, PID 101, processor 207, col.9, ln.16-18); a transceiver coupled to the processor (see figure 2, transmitter 217, receiver 203), the transceiver configured to receive and transmit communication signals (see figure 2, transmitter 217, receiver 203); a memory coupled to the processor (see figure 2, memory 209, processor 207); and a program stored in the memory and running on the processor configured to receive an association signal by the transceiver (see col.10, ln.53-67), the association signal providing an indication of adjacent resources (see figure 1, object identification device 107a send a resource signal to PID 101a, the signal 109a is associated with object 103a, col.9, ln.23-54), the program further configured to access a database including a table storing relationships between data stored on the portable electronic device and the association signal (see figure 1, col.9, ln.10-54, when PID 101a receives the signal from OID 107a, the processor will access to the storage

device 205 for checking the associated data that corresponding to the receiving signal), and the program configured to index the data based on the relationships accessed in the database (see figure 4, col.10, ln.11-53, i.e., index is corresponding objected identifier 401, objected type 403).

It should be noticed that Albuberk fails to teach the association signal includes a Bluetooth signal. However, Schulze teaches such features (see col.13, [0174]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Schulze into view of Albuberk, in order to communicate in short range.

Regarding claims 5, 15, and 25, Schulze further teaches the method and portable electronic device wherein the association signal includes an IEEE 802.11 signal (see col.13, [0174]).

Regarding claims 6, 17, and 27, Schulze further teaches the method and portable electronic device wherein the association signal includes a biometric signal (see col.13, [0174]).

(10) Response to Argument

Regarding the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. Appellant state that the examiner has failed to establish a prima facie case of obviousness under 35 U.S. C 103 (see page 7, first & second paragraphs of the Appeal Brief).

In contract to appellant's assertions, a prima facie case of obviousness is established when the teaching of the prior art would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In re Rinehart, 189 USPQ 143 (CCPA 1976). In this case, Albukerk teaches all the subject matter of claimed limitations in this pending application,

except for a prioritizing the data. Albukerk illustrates in figure 2 the storage device (205) of a personal interpretive device (101) for storing an identifier of each object and providing information about the object to the user who is in vicinity of the object (see column 8, lines 1-12, column 9, lines 24-30). On the other hand, Colson teaches a prioritization system 10 includes a database for storing the prioritizing data to be used in a data synchronization process at a prioritization system (see figure 1, sync engine 11, database 12, [0030]). Since both references teach the storage or database for storing the data in the electronic device, they are indeed in the same field of endeavor or analogous arts. Moreover, sorting data in order by giving priority to data is well known in the data processing. Therefore, there is an existing a strong prima facie case of obviousness under 35 U.S.C 103. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Colson (e.g., technique prioritizing the data in the computer device) how to process the priority data storing in the database.

Regarding the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. Appellant state that there is no motivation to combine of Albukerk reference and Colson reference (see page 7, first & second paragraphs of the Appeal Brief).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Albukerk teaches the storage device (205) of a personal interpretive device (101) for storing an identifier of each object and providing information about the object to the user who is in vicinity of the object (see column 8, lines 1-12, column 9, lines 24-30). On the other hand, Colson teaches a prioritization system includes a database for storing the prioritizing data to be used in a data synchronization process at a prioritization device (see figure 1, sync engine 11, database 12, [0030]). Since both references teach the storage or database for storing data in the electronic device. Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albukerk in order to store and process the priority data in the database so that only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012]).

Regarding the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. Appellant state that the examiner has apparently engaged in hindsight reasoning to combine Albukerk reference and Colson reference (see page 8, first paragraph of the Appeal Brief).

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971). In this case, the examiner has established a strong prima facie case of obviousness on page 8, second paragraph of this examiner's answer and to provide proper suggestions to combine Albukerk and Colson on page 9, second paragraph of this examiner's answer. Therefore, the combination of Albukerk and Colson are proper, and it is not hindsight as arguing by appellant.

Regarding the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. Appellant argues that the prioritization system 10 of Colson would not work with the teaching of Albukerk (see page 8, second paragraph of the Appeal Brief).

In response to appellantt's argument that the entire invention of Colson would not work with the teaching of Albukerk, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Kellert 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The applicant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of Albukerk reference and Colson reference. Furthermore, Examiner only uses the teaching of Colson to show how to process the priority data in the database to incorporate with the teaching of Albukerk to meet the claimed invention.

Regarding the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. Appellant argues that Colson teaches away from a handheld computer configured to prioritize its own data (see page 8, second paragraph of the Appeal Brief).

In contrast to appellant's assertions, teaching a different way is not considered as teaching away. Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Albukerk teaches a system and method for storing data in memory such as objected identifiers. Colson, teaches a system and method for storing data such as the most used telephone numbers, email addresses, etc. in memory. Colson further teaches prioritizing the data in order to sort them in a particular order. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Colson into the teaching of Albukerk for the purpose quickly and easily accessing to the most used telephone number and/or email address. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the concept of prioritizing the data in order to sort them in a particular order as taught by Colson is utilized of whether the prioritizing system 10 is portable or not.

(11) Conclusion

For the above reasons, it is believed that the rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 should be sustained.

Respectfully submitted,

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Art Unit 2618

Conferees

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